



ATTORNEY DOCKET NO. 03221.0003U2

PATENT

3738

#8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Bowman et al.

Serial No.: 10/081,116

Filed: February 21, 2002

For: TWO-LAYER EXTERNAL BREAST
PROSTHESIS WITH SELF-SHAPING
FEATURE AND PROCESS FOR
MANUFACTURE THEREOF

) Art Unit: 3738

) Examiner: Isabella, David J.

) Confirmation No: 8546

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NEEDLE & ROSENBERG, P.C.
Customer Number 23859

July 30, 2003

Sir:

This paper is submitted in response to the Office Action mailed on July 7, 2003, in which a Restriction Requirement has been made.

The Examiner requires the Applicant to elect a single invention for prosecution on the merits from one of two patentably distinct inventions believed by the Examiner to be present in the application. The Examiner contends that these two patentably distinct inventions are those of:

Invention I Claims 1-19, drawn to a breast prosthesis, classified in class 623, subclass 7; and

Invention II Claims 20-26, drawn to a process for manufacturing a breast prosthesis, classified in class 249, subclass 55.

The Applicant hereby provisionally elects invention II, as set forth in claims 20-26, with traverse.

The Applicant respectfully requests that claims 1-19 of Invention I be combined with claims 20-26 of Invention II for examination purposes, and that the restriction requirement be reconsidered as it is not shown in the Office Action that a serious burden would be required to examine the pending claims of Inventions I and II, respectively, in the instant patent application. Specifically, M.P.E.P § 803 provides:

If the search and examination of an application can be made without serious burden, the Examiner *must* examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis supplied.*)

Thus, for a restriction requirement to be proper, the following two criteria must be satisfied: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden in the matter. See M.P.E.P § 803.

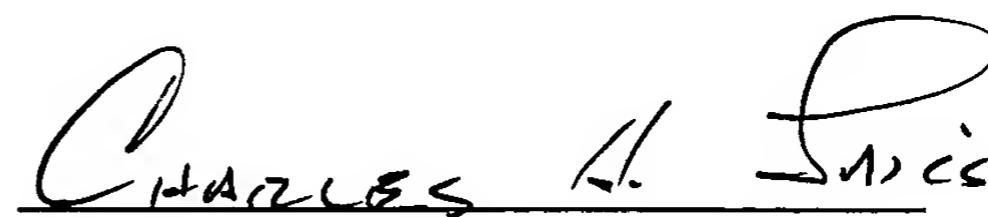
The Office Action has not shown that the second requirement has been met. Specifically, it has not been shown that it would be a serious burden to search and examine all of the claims of Groups I and II together. Consequently, reconsideration and modification or withdrawal of the restriction requirement to this extent is respectfully requested.

Should the Examiner have any questions regarding the Applicant's response to the Restriction Requirement, or which may advance the efficient prosecution of the application, the Examiner is courteously invited to contact the undersigned at the telephone number and address listed below.

No fee is believed to be due herewith. However, the Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any fee overpayment therefor to, Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

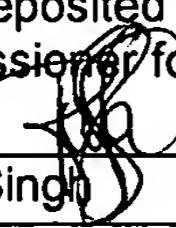


Charles H. Fails
Registration No. 37,616

Customer Number 23859
678-420-9300 PHONE
678-420-9301 FACSIMILE

CERTIFICATE OF MAILING

I hereby certify that this document and any documents referenced herein as being enclosed herein is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.



Ruma Singh

Date

7/30/03